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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,618	06/07/2001	Katsuyuki Yomogida	IWA-171-PCT	5189

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EXAMINER
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COLE, MONIQUE T

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/857,618

Applicant(s)

YOMOGIDA ET AL.

Examiner

Monique T. Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 2, 4, 12 & 15 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step is: a step indicating the presence of the inert gas in the final collecting step. A review of the specification working examples indicates each of the aforementioned omitted steps is present to carry out the disclosed invention. Moreover, each of these steps is necessary to clarify the distinctions between the claimed invention and the prior art reference. Further clarification is required.

3. Claims 5-11, 13 & 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended the instant claims to reflect that a fragrance collection liquid collects the fragrance ingredient. However, Applicant has not achieved the presumed goal of trying to set forth the fragrance collection liquid as a component of the perfume/cosmetic composition. The claims are currently written with the fragrance collection liquid portion added to the "preamble" of the claim, not the clause wherein the components of the composition are affirmatively set forth. As such, the amendment does not serve to add an additional component to the composition claims.

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4. Claim 1 recites the limitation "a fragrance ingredient" in line 6. There is insufficient antecedent basis for this limitation in the claim. How is this fragrance ingredient derived? Further clarification is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 6, 7, 9, 10, 11, 13 & 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USP 4,920,096 to Bedoukian (herein referred to as "Bedoukian").

Bedoukian teaches a perfume/cosmetic composition comprising cedar wood extract oil.

See abstract and col. 1, lines 10-12.

Bedoukian differs from the instantly claimed invention in that the cedar extract is not obtained as recited in the instant claims. However, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product

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in the product-by-process is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Once a product appearing to be substantially identical is found and a 35 USC 102/103 rejection is made, the burden shifts to the applicant to show an unobvious difference. See MPEP 2113.

Bedoukian further differs from the instantly claimed composition in that it does not recite the presence of a fragrance collection liquid. However, as mentioned in the discussion of the 112, 2<sup>nd</sup> paragraph rejection of the claims, the instant claims do not clearly set forth that the fragrance collection liquid is a component of the composition. As such, the present rejection remains.

8. Claims 5, 6, 7, 8, 9, 10, 11, 13 & 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USP 4,444,982 to Nagashima et al. (herein referred to as "Nagashima").

Nagashima teaches a perfume composition comprising agarwood extract. **See col. 1, lines 25-35.**

Nagashima differs from the instantly claimed invention in that the agarwood extract is not obtained as recited in the instant claims. However, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Once a product appearing to be substantially identical is found and a 35 USC 102/103 rejection is made, the burden shifts to the applicant to show an unobvious difference. See MPEP 2113.

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Nagashima further differs from the instantly claimed composition in that it does not recite the presence of a fragrance collection liquid. However, as mentioned in the discussion of the 112, 2<sup>nd</sup> paragraph rejection of the claims, the instant claims do not clearly set for that the fragrance collection liquid is a component of the composition. As such, the present rejection remains.

7. Claims 5, 6, 7, 9, 10, 11, 13 & 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USP 5,321,006 to Mookherjee et al. (herein referred to as "Mookherjee").

Mookherjee teaches a perfume/cosmetic composition that comprises the fragrant extract from a tree and an alcohol that may be admixed so that the combined odors of the individual components produce a pleasant and desired fragrance. See abstract; col. 7, lines 11-20 and col. 7, line 67-col. 8, line 11.

It is noted that the instant claims require that the fragrance collection liquid is the liquid that is used within the context of Applicant's claimed method of collecting a fragrance. However, this limitation constitutes a product-by-process limitation because Applicant is claiming not the actual perfuming component (water, methanol, ethanol, isopropanol, diethylether, pentane, hexane, propyleneglycol, glycerin-Found on page 4, paragraph [0022] of the specification), but rather a method limitation does not bear on the product itself. Although, product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a

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different process. Once a product appearing to be substantially identical is found and a 35 USC 102/103 rejection is made, the burden shifts to the applicant to show an unobvious difference. See MPEP 2113.

Here, it is the Examiner's position that since the instant claims require a fragrant wood extract and a fragrance collection liquid which has been defined as an alcohol in the specification, the Mookherjee disclosure reads on the claims. Thus, the claims are rejected as being anticipated by, or in the alternative, obvious over Mookherjee.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mookherjee in view of Nagashima.

Mookherjee teaches a perfume/cosmetic composition that comprises the fragrant extract from a tree and an alcohol that may be admixed so that the combined odors of the individual components produce a pleasant and desired fragrance. See abstract; col. 7, lines 11-20 and col. 7, line 67-col. 8, line 11.

Mookherjee differs from the instantly claimed invention in that it does not disclose that the fragrant wood is agarwood.

Nagashima teaches a perfume composition comprising natural agarwood extract. See **col. 1, lines 25-35.**

It would have been obvious to one having ordinary skill in the art to use agarwood to derive a natural wood extract composition since Mookherjee teaches that any fragrant wood would be useful in creating the fragrance composition disclosed therein.

***Response to Arguments***

9. Applicant's arguments filed 3/4/2005 have been fully considered but they are not persuasive.

With respect to the rejection of claims 5-11, 13 & 14 under 35 USC 112, 2<sup>nd</sup> paragraph, Applicant did not respond to the pending rejection. As such, this rejection remains.

With respect to the rejection of claims 1, 2, 4, 12 & 15 under 35 USC 112, 2<sup>nd</sup> paragraph, as lacking essential steps, Applicant's arguments are unconvincing to the extent that they relate to the presence of the inert gas. Applicant argument boils down to the fact that in one paragraph of the specification, namely paragraph [0049], there is no mention of the requirement of the inert gas, even though all other portions of the specification require it. Inspection of the named paragraph, there is no mention of any gas. Is one of skill to expect that this manufacturing method does not require a gas? No, it is more likely that one of ordinary skill reading the specification would expect that this manufacturing method like all others in the specification would utilize an inert gas. Moreover, even if one were to be led to think otherwise, there is no teaching or suggestion in the specification that would guide him or her to select any gas other than an inert gas. As such, this rejection is being maintained.

10. With regard to the Applicant's remarks concerning the distinctions between the instant invention and the Bedoukian, it is the Examiner's position that Applicant's statements refer to what Applicant invention does, not what is being claimed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., allowing the vapor of the extract to pass over while retaining the solvent; exclusion of toluene as a solvent) are not recited in the rejected claim(s).



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Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to Applicant's remarks concerning Nagashima & Mookherjee, they amount to unsubstantiated arguments addressing a product-by-process. However, "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Moreover, the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include statements regarding *unexpected results*, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant (emphasis added). Here, it is insufficient for Applicant to assert, without supporting evidence, that a product different than the products disclosed in Nagashima & Mookherjee is made by the instant claims. As such, the instant rejections are being maintained.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique T. Cole whose telephone number is 571-272-1255. The examiner can normally be reached on Monday-Thursday from 6:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Monique T. Cole  
Primary Examiner  
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mtc